

Appl. No. 10/049,497
Atty. Docket No. CM2140
Amdt. dated February 3, 2005
Reply to Office Action of November 3, 2004
Customer No. 27752

REMARKS

Application Amendments

Claims 1-4 and 8-10 are pending in the present application. No claim amendments have been made.

Rejections Under 35 USC 103(a) Over US Patent No. 5,290,562 to Meybeck et al. in view of JP 57-109711 to Hideo et al.

Claims 1-4 and 8-10 are rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,290,562 to Meybeck et al. ("Meybeck") in view of JP 57-109711 A to Hideo et al. ("Hideo"). The Examiner asserts that Meybeck discloses cosmetic compositions which contain methyl tyrosinate, ethyl tyrosinate, or stearyl tyrosinate, and which can be used for "increasing the content of melanin and thus improve the hair complexion." Office Action at page 2. The Examiner also asserts that Meybeck teaches the use of tyrosine esters, such as methyl or ethyl tyrosinate, incorporated in liposomes in cosmetic compositions because tyrosine does not easily penetrate across the corneum layer of the skin. The Examiner concludes that Meybeck teaches the use of the compositions containing tyrosinate salts "for both skin melanogenesis as well as for improve [sic] the complexion or retard the graying of hair (example 8)." *Id.* However, the Examiner notes that Meybeck does not teach the use of at least one other amino acid and a hair conditioning agent as claimed.

The Examiner additionally asserts that Hideo discloses a hair cosmetic composition comprising quaternary ammonium compounds and an amino acid selected from glycine, valine, histidine, tryptophan, threonine, etc. The Examiner asserts that the quaternary ammonium compound of Hideo reads on the conditioning agent of Applicants' claims, and that the composition of Hideo provides excellent combing and softness effects to the hair. Thus, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to combine the composition of Hideo with the composition of Meybeck because both Meybeck and Hideo teach compositions for improving hair conditions. Specifically, the Examiner states that one of ordinary skill in the art would have expected to improve the hair combing and softness effects while

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simultaneously treating graying hair. Applicants respectfully traverse the present rejection based on the following comments.

There is no suggestion or motivation to combine Meybeck and Hideo, and, thus, a *prima facie* case of obviousness has not been established (MPEP 2143.01). Moreover, the mere fact that Meybeck and Hideo can be combined does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants' claim 1 is directed to a hair care composition comprising at least one ester derivative of tyrosine and at least one other amino acid compound selected from tryptophan compounds, histidine compounds and lysine compounds, and a cosmetically acceptable carrier which is suitable for use on hair and which comprises one or more hair conditioning agents selected from the group consisting of silicone conditioning agents and cationic conditioning agents. The hair care compositions of Applicants' invention target the hair shaft, providing the benefit of improved strength and condition of the hair. It has been found that the levels of certain amino acids are reduced in damaged hair in comparison to undamaged hair. Applicants' hair care compositions provide the benefits of improved strength and improved condition to damaged hair with the specific combination of amino acid compounds claimed and the hair conditioning agents.

Meybeck teaches and claims compositions and their methods of use for increasing melanin formation on the skin and the scalp. The Examiner points to Example 8 of Meybeck as support for the assertion that the composition of Meybeck improves the condition of hair because the composition is taught to retard the appearance of gray hair as well as to improve melanogenesis in the skin. However, the composition of Meybeck does not retard the appearance of gray hair by targeting the hair shaft. In particular, the composition of Meybeck does not act analogous to, for example, a hair coloring composition which affects the color of the shaft of existing hair. Instead, the composition of Meybeck acts on the scalp, penetrating the epidermis to improve melanin formation in the hair follicle and in newly growing hair. Notably, Example 8 of Meybeck expressly states that "[t]his lotion, applied morning and evening to the scalp, retards the appearance of grey hair" (emphasis added). Nothing in the disclosure of Meybeck teaches or

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suggests targeting the shaft of existing damaged hairs for application of the composition of Meybeck.

In contrast, the composition of Hideo provides the alleged benefits of improved combing and hair softness by targeting the shaft of existing hair. Hideo is directed to a hair cosmetic composition comprising an amino acid and a certain quaternary ammonium salt in a specific ratio. The composition of Hideo can be used as either a rinse-out or leave-in type hair cosmetic. However, Hideo fails to teach or suggest applying the hair cosmetic composition to the skin or the scalp such that benefits would be provided when the composition penetrates the epidermis.

The disclosure of Meybeck addresses a problem which is separate and different from the problem addressed in the disclosure of Hideo, and, consequently, Meybeck teaches a composition which functions in a manner different from the manner in which the composition of Hideo functions. Namely, the composition of Meybeck targets the skin or the scalp to improve melanin formation below the epidermis. The composition of Hideo, conversely, targets the shaft of existing hair above the skin to improve the condition of that hair. The Examiner has offered no other suggestion or motivation for combining Meybeck and Hideo, aside from that "both Meybeck and [Hideo] teach compositions for improving hair conditions and accordingly the motivation to combination *[sic]* the references flows logically." Office Action at page 3. Applicants respectfully submit that, without some additional motivation, one of ordinary skill in the art would not look to a composition which provides a benefit by acting below the surface of the skin to modify or improve a composition which provides a benefit to the shafts of damaged hair above the surface of the skin.

Accordingly, the combination of Meybeck and Hideo does not establish a *prima facie* case of obviousness. Therefore, Applicants' claims 1-4 and 8-10 are novel and nonobvious over the combination of Meybeck and Hideo.

CONCLUSION

In light of the remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

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Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of Claims 1-4 and 8-10.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By M. Dressman

Signature

Marianne Dressman

Typed or Printed Name

Registration No. 42,498

(513) 626-0673

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